

Application No. 10/063315
Page 4

Amendment

REMARKS

This Amendment is in response to the Final Office Action of February 2, 2006. In the Office Action claims 38 and 46 were objected to as being unclear. Claims 38-40, 44-47, 49, and 51-53 were rejected under 35 USC 102(b) as being anticipated by US patent 5,591,198 to Boyle et al. Claims 41, 43, 48, and 50 were rejected as being unpatentable over Boyle in view of US patent 6,258,117 to Camrud et al. Claims 38 and 46 have been amended without prejudice or disclaimer. No new matter has been introduced with these amendments. These rejections are addressed below under headings consistent with those of the Final Office Action.

Claim Objections

In the Office Action, claims 38 and 46 were objected to as being unclear due to the language "the coil segments having curved portions". In order to clarify this language to the Examiner's satisfaction, Applicant directs the Examiner to paragraph 50 around line 5 of the original specification which states, "Coil stent segment 100 comprises first curved segment 114a and second curved segment 114b". The "curved portions" of the claims correspond to the "curved segments" of paragraph 50. Please also note Fig. 7a which illustrates the curved segments. Applicant respectfully requests withdrawal of the objection.

35 USC §102(b)

Claims 38-40, 44-47, 49, and 51-53 were rejected under 35 USC 102(b) as being anticipated by US patent 5,591,198 to Boyle et al.

Applicant has amended claims 38 and 46 without prejudice or disclaimer. Boyle et al does not disclose the immediately adjacent curved portions as claimed in amended claims 38 and 46. The coil section 15 of Boyle as defined by the Examiner has a sinusoidal like shape. The immediately adjacent curved portions do not maintain a substantially constant distance from each other longitudinally along their length. In fact, Figs. 1-6 of Boyle illustrate portions longitudinally adjacent one another varying significantly with regard to their proximity together as one portion of a sinusoidal almost touches another portion of a longitudinally adjacent sinusoidal. For at least this reason claims 38 and 46 and those claims dependent thereof overcome the 102(b) rejection in light of Boyle. Applicant respectfully requests that the rejection

Application No. 10/063315
Page 5

Amendment

be withdrawn.

35 USC §103

In the Office Action, claims 41, 43, 48, and 50 were rejected as being unpatentable over Boyle in view of US patent 6,258,117 to Camrud et al. Applicant disagrees with the rejection.

One skilled in the art would not look to a multi-section stent as that of Camrud when constructing the stent of the cited claims as such a combination would destroy the intended functionality of the stent of Boyle as well as that of the instant claims (*In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)) (MPEP 2143.01, V). Camrud teaches a stent having identical sections separated by a portion that breaks or weakens. Such a combination would destroy the intended use of the stent of Boyle in that the greater metal mass at the ends of the stent of Boyle achieves better visualization under fluoroscopy. The identical segments of Camrud do not provide this benefit as the ends are not so easily determined. This is additionally the case when connection to the stent is broken. Such breaking or weakening of the connection between sections also destroys the intended use of the instant claims. The instant claims teach a stent with a coil section and a serpentine section that have complementary functions that would be destroyed if the connection between them was broken or weakened. In contrast, the sections of Camrud are identical and serve the same function rather than complementary functions. This loss of functionality is not acceptable when combining references.

Camrud does not teach or suggest a stent having both a coil section and a serpentine section as all the sections of Camrud are identical. Similarly, Boyle does not teach or suggest a stent that is self-expanding or that has connections between sections that break or weaken. Furthermore, the level of skill in the art cannot be relied upon to provide the suggestion to combine references (*Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)) (MPEP §2143.01, I). It is only through the impermissible use of hindsight that this combination could be made. Thus, the combination is inappropriate (*In re Fine*, 5 USPQ 2d, 1596 (1988) (Fed. Cir. 1989)) (MPEP §2143.01, I).

For at least these reasons, Applicant respectfully requests that the obviousness rejection of claims 41, 43, 48, and 50 be withdrawn.

Application No. 10/063315
Page 6

Amendment

Conclusion

In view of the foregoing it is believed that the present application, with claims 38-41 and 43-53, is in condition for allowance. Early action to that effect is earnestly solicited.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: March 9, 2006

By: 

Brendan C. Babcock
Registration No.: 50705

6109 Blue Circle Drive, Suite 2000
Minnetonka, MN 55343-9185
Telephone: (952) 563-3000
Facsimile: (952) 563-3001
f:\wpwork\beb\10039us01_and_20060219.doc